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10/730,097	12/09/2003	Masashi Eguchi	032095	2681
38834 7590 08/22/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
QIN, YIXING				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/730,097

**Applicant(s)**

EGUCHI ET AL.

**Examiner**

Yixing Qin

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, filed 5/13/08 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Itoh (PG Pub. No. 2002/0097443). Itoh is in the same field of endeavor of dividing up a larger image into pieces to be read and transferred. Certain previously cited references are still used for dependent claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh (PG Pub. No. 2002/0097443) in view of Uchikawa (U.S. Patent No. 6,499,068)

Regarding claim 1, Itoh discloses a facsimile machine comprising: means for scanning an original document to generate image data;

means for detecting whether an amount of the image data exceeds a prescribed amount; (Fig. 1, item 3 P[0030] – division/reduction unit 3 is used to detect whether a size is exceeded.)

means for dividing the image data in parallel with the scanning of the original document each time the amount of the image data is detected to exceed the prescribed amount; (Abstract and P[0010] – where the reading means determines that the width in a main scanning direction of a image bigger than A3. Also see P[0030] ) and

It does not explicitly disclose “means for transmitting each divided image data by electronic mail. “

However, Uchikawa discloses in Fig. 3 a mail transmissions component 3008 for email transmissions.

Itoh and Uchikawa are combinable because both are in the art of faxing documents.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used email as a transmission mechanism.

The motivation would have been to use a known substitute method of transmission to send data.

Therefore, it would have been obvious to combine Itoh and Uchikawa to obtain the invention as specified.

Regarding claim 2, Uchikawa discloses “wherein the means for transmitting further includes means for establishing a connection with a remote device when the scanning of the original document is started. “ ( column 3, lines 47-64)

Regarding claim 3, Uchikawa discloses the facsimile machine according to claim 2, wherein the means for transmitting further includes means for maintaining the connection with the remote device until all divided image data are transmitted. (column 3, lines 47-64. Although not explicitly stated, a connection is kept in order for data to be properly transmitted)

Regarding claim 5, Itoh discloses a facsimile machine comprising: means for scanning an original document to generate image data;

means for detecting whether an amount of the image data exceeds a prescribed amount; (Fig. 1, item 3 P[0030] – division/reduction unit 3 is used to detect whether a size is exceeded.)

means for dividing the image data in parallel with the scanning of the original document each time the amount of the image data is detected to exceed the prescribed amount; (Abstract and P[0010] – where the reading means determines that the width in a main scanning direction of a image bigger than A3. Also see P[0030] )

means for transmitting each divided image data by electronic mail; (Again, from claim 1 above, Uchikawa shows Fig. 3 a mail transmissions component 3008 for email transmissions.) and

The secondary reference Uchikawa discloses “means for stopping the transmission of the electronic mail when an error generates in the means for generating.” (column 10, lines 55-60 that when a job that cannot be simultaneously

transmitted is decided as an error, then scanning is prevented because it would be in vain. Thus, a email would not be sent if a scanning procedure is not even finished. Also note in 10, lines 38-49, a job can be decided to be unable to be transmitted. )

Regarding claim 6, Itoh discloses a facsimile machine comprising: means for scanning an original document to generate image data;

means for detecting whether an amount of the image data exceeds a prescribed amount; (P[0042], P[0051] discloses a control unit 31 generates the break signal for dividing image data.)

means for dividing the image data in parallel with the scanning of the original document each time the amount of the image data is detected to exceed the prescribed amount; (P[0042] – a plurality of image files are created when input data is broken at prescribed breaks)

The secondary reference Uchikawa discloses "means for transmitting each divided image data by electronic mail;

means for stopping the scanning of the original document when an error generates in the means for transmitting." (Fig. 3 a mail transmissions component 3008 for email transmissions. In column 10, lines 55-60 that when a job that cannot be simultaneously transmitted is decided as an error, then scanning is prevented because it would be in vain. )

Regarding claim 7, Uchikawa discloses the facsimile machine according to claim 6, further comprising:

means for storing the electronic mail; (Fig. 1, database/mail server 1004) and  
means for retransmitting the electronic mail by outputting the electronic mail from the means for storing when it is determined that the electronic mail can be retransmitted based on contents of the error. (column 10, lines 10-18 – a retry can occur if the number of destinations exceeds the amount of jobs that can be simultaneously processed. )

Regarding claim 8, Uchikawa discloses the facsimile machine according to claim 6, further comprising:

means for stopping the scanning of the original document and the transmission of the electronic mail when it is determined that the electronic mail cannot be retransmitted based on contents of the error. (column 10, lines 55-60 that when a job that cannot be simultaneously transmitted is decided as an error, then scanning is prevented because it would be in vain.)

Regarding claim 9, Itoh discloses a facsimile machine comprising: means for scanning an original document to generate image data;

means for detecting whether an amount of the image data exceeds a prescribed amount; (P[0042], P[0051] discloses a control unit 31 generates the break signal for dividing image data.)

means for dividing the image data in parallel with the scanning of the original document each time the amount of the image data is detected to exceed the prescribed amount; (P[0042] – a plurality of image files are created when input data is broken at prescribed breaks)

The secondary reference, Uchikawa discloses “means for transmitting each divided image data by electronic mail;

means for providing the electronic mail with information regarding an error when detecting the error in the transmitted electronic mail; and

means for retransmitting the electronic mail “(Fig. 3 a mail transmissions component 3008 for email transmissions. Column 10, lines 10-18 that error information is shown and a retry is performed. )

Regarding claim 10, Uchikawa discloses the facsimile machine according to claim 9, further comprising:

means for storing the electronic mail; (Fig. 1, database/mail server 1004) and

means for retransmitting the electronic mail by outputting the electronic mail from the means for storing when it is determined that the electronic mail can be retransmitted based on contents of the error. (column 10, lines 10-18 – a retry can occur if the number of destinations exceeds the amount of jobs that can be simultaneously processed)



Regarding claim 11, Uchikawa discloses the facsimile machine according to claim 9, further comprising:

means for stopping the scanning of the original document and the transmission of the electronic mail when it is determined that the electronic mail cannot be retransmitted based on the contents of the error. (column 10, lines 55-60 that when a job that cannot be simultaneously transmitted is decided as an error, then scanning is prevented because it would be in vain. Thus, a email would not be sent if a scanning procedure is not even finished. Also note in 10, lines 38-49, a job can be decided to be unable to be transmitted.)

II. Claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh (PG Pub. No. 2002/0097443) in view of Uchikawa (U.S. Patent No. 6,499,068) in view of Oteki et al (U.S. PG. Pub No. 20010019429)

Regarding claim 4, Itoh/Uchikawa discloses the facsimile machine according to claim 1, further comprising:

means for storing the electronic mail means for receiving information regarding reception of the electronic mail from the remote device; (P[0052-0056] – image data is divided to be scanned and then stored. Transmitted data is also stored in storage unit 23)

It does not explicitly disclose "means for erasing the electronic mail from the means for storing when it is determined that the remote device received the electronic mail normally in accordance with the information received from the remote device."

However, the secondary reference, Oteki discloses in P[0160] that data that is completely sent is deleted from the image memory.

Itoh and Oteki are combinable because both are in the art of transferring images.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have deleted completed transmission image data from memory.

The motivation would have been to free up memory space for storing future data.

Therefore, it would have been obvious to combine Itoh and Oteki to obtain the invention as specified.

**V. Claims 12-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh (PG Pub. No. 20040030684) in view of Uchikawa (U.S. Patent No. 6,499,068) in view of Tanimoto (U.S. PG Pub. No. 20020131089)**

Regarding claim 12, , Itoh discloses a facsimile machine comprising: means for scanning an original document to generate image data;

means for detecting whether an amount of the image data exceeds a prescribed amount; (P[0042], P[0051] discloses a control unit 31 generates the break signal for dividing image data.)

means for dividing the image data in parallel with the scanning of the original document each time the amount of the image data is detected to exceed the prescribed amount; (P[0042] – a plurality of image files are created when input data is broken at prescribed breaks)

means for transmitting each divided image data by electronic mail; (P[0041] disclose that email is one of the mean for transfer) and

It does not explicitly disclose “means for providing the electronic mail with information indicating a transmission number of the electronic mail.”

However, Tanimoto discloses in Fig. 8 various emails being sent with respective transmission numbers.

Itoh and Tanimoto are combinable because both are in the art of faxing data.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a transmission number.

The motivation would have been to given a number to emails so that it is known how many mail pieces to expect.

Therefore, it would have been obvious to combine Itoh and Tanimoto to obtain the invention as specified.

Regarding claim 13, the tertiary reference, Tanimoto discloses the facsimile machine according to claim 12, further comprising:

means for providing the electronic mail with information indicating whether subsequent electronic mail will be transmitted. (the secondary reference, Tanimoto, discloses in Figs. 8 and 9 and P[0095-0096] that there is a command that is sent from the sending fax to the receiving fax. This can designate a print order or forwarding order. Since there is a designation of the order, then it would be obvious that subsequent emails will be transmitted given, for example, the first email is transmitted and the designation of order calls for three emails)

Regarding claim 14, the tertiary reference, Tanimoto discloses the facsimile machine according to claim 12, further comprising:

means for providing the electronic mail with information indicating a total number of the electronic mails. (the secondary reference, Tanimoto, discloses in Fig. 8 that there is a total number of 3 files)

Regarding claim 15, the tertiary reference, Tanimoto discloses the facsimile machine according to claim 12, further comprising:

means for providing the electronic mail with page information of the original document. (the secondary reference, Tanimoto, discloses in P[0091] that info is provided of how many pages the image data of the file name has)

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YQ

/David K Moore/  
Supervisory Patent Examiner, Art Unit 2625